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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,950	02/09/2004	Philipp J. Herget	1001	8637
7590 08/18/2005			EXAMINER	
Philipp Herget			NGO, NGAN V	
Apt 5 2015 Wendover St.			ART UNIT	PAPER NUMBER
Pittsburgh, PA 15217-1938			2818	
			DATE MAILED: 08/18/2009	5

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)			
	10/774,950	HERGET, PHILIPP J.			
Office Action Summary	Examiner	Art Unit			
	Ngan Ngo	2818			
The MAILING DATE of this communication app Period for Reply	pears on the cover sheet with the c	orrespondence address			
A SHORTENED STATUTORY PERIOD FOR REPLY THE MAILING DATE OF THIS COMMUNICATION. - Extensions of time may be available under the provisions of 37 CFR 1.1: after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply - If NO period for reply is specified above, the maximum statutory period of the period for reply within the set or extended period for reply will, by statute - Any reply received by the Office later than three months after the mailing - earned patent term adjustment. See 37 CFR 1.704(b).	36(a). In no event, however, may a reply be tim y within the statutory minimum of thirty (30) days will apply and will expire SIX (6) MONTHS from the cause the application to become ABANDONE	nely filed s will be considered timely. the mailing date of this communication. D (35 U.S.C. § 133).			
Status					
1) Responsive to communication(s) filed on <u>06 Ju</u>	ıl <u>y 2005</u> .				
2a) This action is FINAL . 2b) ☑ This	This action is FINAL . 2b) ☑ This action is non-final.				
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is					
closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.					
Disposition of Claims					
4) ⊠ Claim(s) 1-18 is/are pending in the application. 4a) Of the above claim(s) 6-18 is/are withdrawr 5) □ Claim(s) is/are allowed. 6) ⊠ Claim(s) 1-5 is/are rejected. 7) □ Claim(s) is/are objected to. 8) □ Claim(s) are subject to restriction and/o	n from consideration.				
Application Papers					
9) The specification is objected to by the Examine	r.				
10) ☐ The drawing(s) filed on is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.					
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).					
Replacement drawing sheet(s) including the correct 11) The oath or declaration is objected to by the Ex	• • • • • • • • • • • • • • • • • • • •	, ,			
Priority under 35 U.S.C. § 119					
12) Acknowledgment is made of a claim for foreign a) All b) Some * c) None of: 1. Certified copies of the priority documents 2. Certified copies of the priority documents 3. Copies of the certified copies of the priority application from the International Bureau * See the attached detailed Office action for a list	s have been received. s have been received in Application rity documents have been receive u (PCT Rule 17.2(a)).	on No ed in this National Stage			
Attachment(s) 1) Notice of References Cited (PTO-892)	4)				
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>0504</u>. 		atent Application (PTO-152)			

Application/Control Number: 10/774,950

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The election filed July 6, 2005 has been entered and made of record as paper no. 0705.

Applicant's election of claims 1-5 in the reply filed on July 6, 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Katti et al (US-5,375,082).

Katti discloses a storage medium comprising a substrate (12), a magnetic layer (26), and means of selectively introducing a plurality of nucleation sites (28) into the magnetic layer in which the nucleation sites represent the information to be stored. Note lines 40-53 of column 5 of Katti et al.

In re claims 3 and 4, no patentable weight is given to the process of making the nucleation sites in claims drawn to the product. A "product by process" claim is directed to the product per se, no matter how actually made, In re Hirao, 190 USPQ 15 at 17(footnote 3). See also In re Brown, 173 USPQ 685; In re Luck, 177 USPQ 523; In re Fessmann, 180 USPQ 324; In re Avery, 186 USPQ 161; In re Wertheim, 191 USPQ 90 (209 USPQ 554 does not deal with this issue); In re Marosi et al, 218 USPQ 289; and

particularly In re Thorpe, 227 USPQ 964, all of which make it clear that it is the patentability of the final product per se which must be determined in a "product by process" claim, and not the patentability of the process, and that an old or obvious product produced by a new method is not patentable as a product, whether claimed in "product by process" claims or not. Note that applicant has the burden of proof in such cases, as the above caselaw makes clear.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Katti et al in view of Almasi et al (US-3,680,065).

Katti discloses all the subject matter discussed above; however Katti does not teach the magnetic layer being a magneto-optical thin film. Almasi teaches that the magnetic layer can be magneto-optical thin film in magneto-optical memory element. Therefore, it would have been obvious to one of ordinary skill in the art to use the teachings of Almasi to form a magneto-optical memory element in Katti's storage medium.

The other references are cited to show other structures pertinent to Applicant's disclosure.

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Any inquiry concerning this communication should be directed to Examiner Ngan Ngo at telephone number (571) 272-1711. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ngan Van Ngo Primary Examiner

Ngan Ngo

August 16, 2005